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EXAMINER

SHUMATE, ANTHONY R

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## **ATTACHMENT TO ADVISORY ACTION**

### ***Response to Arguments***

1. The Applicant requests that the amendment be entered after Final.

In response, the entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Respectively, the amendment does not merely cancel claims or comply with a formal requirement made earlier.

2. Applicant argues at page 6 that " Claim 3 is objected to, as an improper dependent, because the phrase 'support comprises' in claim 3 is allegedly inconsistent with the language 'consisting of' used in claim 1;" "The use of 'comprises' in claim 3 is not inconsistent with the 'consists of' language used in claim 1 because the support material may consist of alumina plus any of the other support materials listed in the 'consisting of' group in claim 1, namely titania, magnesia, silica -alumina or a calcium-aluminate cement."

- a. Respectively, the Examiner does not find the argument persuasive. The Applicant has not provided evidence that the 'comprises' in claim 3 should be held as meaning "the support material may consist of alumina plus any of the other support materials listed in the 'consisting of' group in claim 1, namely titania, magnesia, silica -alumina or a calcium-aluminate cement."

- b. Also, the Applicant argues that the 'comprises' in claim 3 includes additional elements titania, magnesia, silica -alumina or a calcium-aluminate

cement besides the alumina, which actually at least to some degree actually supports the Examiner's objection; because the Applicant agrees that the comprises language is open ended (i.e. includes additional elements besides the alumina). Respectively, the Applicant has not provided clear and convincing evidence that the open ended language of claim 3 is limited to merely the additional elements such as titania, magnesia, silica-alumina or a calcium-aluminate cement. Therefore, the objection is maintained.

3. Applicant argues the rejection under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement because "First, a person of ordinary skill in the art would recognize that all of the examples demonstrate catalysts containing only the elements recited in claim 1. In particular, each of the examples disclose only Pd with a lanthanide on an alumina support."

a. Respectively, the Examiner does not find the argument persuasive. The Applicant is not claiming "only Pd with a lanthanide on an alumina support." Applicant's argument is not commensurate in scope with the claims.

4. Applicant argues the rejection under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement because "Second, the original claims recited that 'the catalyst consists essentially of,' which would surely encompass the catalyst consisting of only those recited elements."

a. Respectively, the Examiner does not find the argument persuasive. The original claims did not recite that "the catalyst consists essentially of."

b. Secondly, the "consists essentially of" language is broader than the "consisting of" language.

5. Applicant argues the rejection under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement because "Third, the specification discloses a layer of only Pd and the lanthanide compound at or near the surface of the support. See page 6, lines 30-38 of the specification."

a. Respectively, the Examiner does not find the argument persuasive. Page 6, lines 30-38 of the specification does not disclose "a layer of only Pd and the lanthanide compound at or near the surface of the support."

b. Page 6, lines 30-38 of the specification states, "It is preferred that the Pd and preferably also the lanthanide compound is present only in a layer at or near the surface of the support, i.e. that the catalyst is of the 'shell' type. It is known that for use in selective hydrogenation, it is beneficial to use a catalyst in which the active component is concentrated in a relatively thin layer near the surface in order to minimize the contact time of the gas stream with the active catalyst and thereby increase selectivity " (i.e. the specification is describing the position of the Pd and preferably the lanthanide; and, respectively, not what the Applicant alleges).

Art Unit: 1797

6. Applicant argues the rejection under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement because "Lastly, Applicants note that there is no restriction on changing the scope of the claims during prosecution as long as the requirements of Section 112 are met, as they are here."

a. Respectively, the Examiner does not find the argument persuasive. The Examiner does not find the circular argument persuasive. Merely, asserting that the "the requirements of Section 112 are met" is not a basis to overcome the rejection under 35 U.S.C. § 112.

2. Applicant argues at pages 8-13 that the amendment to the claims provided in the Amendment After Final overcomes the rejections. This position is supported by the Applicant beginning the discussion about the rejections under 35 USC 102 and 35 USC 103 at pages 8-13 by discussing the amendment to the claims provided in the Amendment After Final at page 8.

3. In response to any remaining arguments not already addressed, absent any further teaching as to why or how the previous objection(s) and/or rejection(s) are improper the Examiner does not find the argument(s) persuasive and maintains the rejection(s).